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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/255,737 02/23/99 MEAD

J 3797.77744

EXAMINER

TM02/0606

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**RECEIVED**

BERGIN, J

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BANNER & WITCOFF LTD.

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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LAST DAY 06 DE 2001

<b>Office Action Summary</b>	Application No. 09/255,737	Applicant(s) MEAD ET AL.	
	Examiner James S. Bergin	Art Unit 2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 February 1999.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- |   |  |
|---|--|
| 15) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 16) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)              | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> . | 20) <input type="checkbox"/> Other:  |

## DETAILED ACTION

### *Information Disclosure Statement*

1. The information disclosure statement filed 7/6/99 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. **The mere citation of a web address is not a publication that can be considered by the examiner. Dated printouts from the web address or dated publications relating to the content of the web address would be considered.**

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 1-15** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 11, it is unclear if the computer referred to by "a computer", is the same computer as the, "a computer", referred to in line 3 of the same claim. Similarly, each recitation of "computer user" in the claim is indefinite because it is unknown to which computer, of the potential plurality of computers, is being used by the user?

4. The term "immediately" in claim 14 is a relative term, which renders the claim indefinite. The term "immediately" is not defined by the claim, the specification does not

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provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention. The precise amount of time encompassed by the term immediate is unknown: a nanosecond, a second, 5 seconds,..... etc.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claim 16** is rejected under 35 U.S.C. 102(b) as being anticipated by Hazy et al. (CA 2,122,116).

Hazy et al. disclose a computer implemented method of providing investment information to a computer user comprising the following steps which are either explicitly or inherently disclosed therein: receiving in a computer, at alert service 220, a plurality of data feeds (page 4, lines 3, 4) each including information concerning a plurality of investments (page 5, line 14-36); parsing the data feeds to extract both quantitative (page 2, lines 29, 30) and non-quantitative data items (page 5, lines 32-36) relevant to the investments; comparing the extracted data item to one of several triggers, said triggers comprising an association between a predefined criterion of interest and one of the extracted quantitative data items; setting an alert for that trigger if this comparison reveals a match; and displaying on a remote computer screen (page 5, lines 14-19)

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associated with the computer user one or more alerts that have been set for an investment selected by the computer user.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 1-15, and 17-27** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hazy et al. (CA 2,122,116).

Regarding claims 1 and 4, Hazy et al. disclose a computer-implemented method of providing investment information to a computer user comprising the steps outlined above. However, Hazy et al. discloses that the criterion of interest is user-specified rather than being specified by a person other than the computer user. The examiner takes official notice of the fact that it is well known that trained and experienced investment professionals have, when compared to the knowledge level of the average amateur investors, a superior knowledge on the average of which particular investment performance criterion or indicators to watch for a particular portfolio. It would thus have been obvious, to one of ordinary skill in the art at the time that the invention was made, to have the criterion of interest in the Hazy et al. method, be selected by an investment professional rather than the computer user, such a modification utilizing the superior

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knowledge of an investment professional and returning better yields to the customer over the long haul.

Regarding claims 2, 3, 5-15, 17-22, and 24-27 the examiner takes official notice that all of the limitations therein comprise basic and elementary components of database hardware, database software, query software and browser software, all of which were well known to those of ordinary skill in the art at the time that the invention was made. Thus to include each, all or any combination of these claimed elements in the Hazy et al. method or system, would only have included that which is old and ubiquitously well known to those of ordinary skill in the art at the time that the invention was made, with such an inclusion allowing a system designer to customize the system to the needs of a particular client, application or environment.

Regarding claim 23, Hazy et al. disclose a system for performing the Hazy et al. computer implemented method as described above. The Hazy et al. disclosure of an alert engine 130 and action processor 140 does not explicitly state that it comprises a truth file or table. It may very well comprise such a truth table. (page 3, line 29 – page 4, line 12). However, in the event that the applicant believes that such a truth table is not inherent in the disclosure, Hazy et al. state that *“the monitoring and alerting service method has not been limited to specified hardware or software. Instead, the method has been described in such a manner that those skilled in the art can readily adapt such hardware and software as may be available or preferable in developing embodiments for these and additional applications* (page 7, lines 15-22). This motivation to adapt hardware and software as needed or desired would provide motivation to incorporate a

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truth table in the Hazy et al. system, truth tables being extremely basic software components of database systems, and known to even those possessing the most elementary knowledge of database and query software. Thus, to provide the Hazy et al. alert engine with a truth table (if such is absent), would have been obvious to one of ordinary skill in the art at the time that the invention was made, such an inclusion of a truth table incorporating only that which was known to even those possessing the most elementary knowledge of database and query software and being motivated by the hardware and software adaptability of the Hazy et al. system and method.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Toy (4,554,418) discloses a relevant prior art stock alert system and method, Vanden Heuvel et al. (5,426,422) discloses another relevant prior art stock alert system and method, Barr et al. (5,761,442) discloses a relevant predictive neural network means including momentum, growth and value stock alerts, Bates et al. (6,088,707) discloses hypertext links used in a stock alert application environment, Shaffer et al. (6,094,681) disclose relevant prior art stock notification alerts, French (6,188,992) disclose investment agents and triggers therefor, Baclawski (6,192,364) discloses intelligent agents employed in a distributed computer database system, Lazaridis et al. (6,219,694) discloses relevant intelligent agents for generating stock quotes. The following non-patent literature has been cited to provide examples of the state of the art in investment alert art: Resnick, Rosalind, "Serial portfolio", December, 1992, Compute, v14, n11, p90 (4); Schroeder, Mary, "On-line Brokerage Industry

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Takes Off", January 4, 1999, Securities Data Publishing; Steinhart, David, "E-trading volumes gather steam....", December 29, 1998, Financial Post, p01; Ferguson, Tim, "Do it yourself", April 22, 1996, Forbes, v157n8, PP 70-80; "STOCK OF THE WEEK: E\*TRADE GROUP INC.", November 16, 1998, The Sacramento Bee, p1B.8; Schroeder, Mary, "E\*Trade Rolls Out Destination E\*Trade.....", June 29, 1998, Securities Data Publishing; "E\*Trades New Destination Financial Services Web Site Attracts.....", December 28, 1998, PR Newswire, p9800; Stone, Amey, "All-in-one accounts look even more appetizing", October 31, 1994, Business Week, n3396, PP: 130-131; "Schwab to Launch E-Mail Alert System", December 21, 1998, Financial NetNews, v III, n 51, p 1+; Herman, Tom, "On Your Own---Does it Compute?.....", November 30, 1998, Wall Street Journal, pR, 21:1; and "Boston Equity, Research Group, Inc. Announces the Availability of their Research Program through FIRST CALL Research Direct", October 15, 1997, PR Newswire, p1015NEW024.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James S. Bergin whose telephone number is 703 308-8549. The examiner can normally be reached on Monday-Thursday 8.30-6.00 and on alternate Fridays.

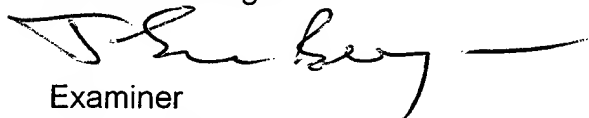
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703 308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are 703 308-1396 for regular communications and 703 308-1396 for After Final communications.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-3900.

James S. Bergin



Examiner

June 1, 2001



VINCENT MILLIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100